



AF-20

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Oleg B. Rashkovskiy

Serial No.: 09/690,549

Filed: October 17, 2000

For: Storing Advertisements

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Art Unit: 2623

Examiner: Rueben M. Brown

Atty Docket: BKA.0006US

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

In response to the new points raised in the Examiner's Answer, the following reply brief is submitted.

1. **Does Rosser Teach Updating Advertisements?**

Despite the absence of anything that can credibly be asserted to be an update, the Examiner continues to find new things within the reference which he tries to call update instructions, but which cannot reasonably be said to have any relationship to updates. The cited reference merely sends the advertisements and never contemplated the use of updates.

The first asserted update is the LVIS instructions and the components thereof asserted to be warping of the insert and selective use of the occlusion mask. The Examiner asserts that the combination of these elements somehow "reads on update instructions," despite the fact that they have no possible relationship to the function of updating. The Examiner is simply grabbing something and calling it an update when it is no such thing. The material cited in column 7, lines

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35-45 talks about information generated by various units to perform seamless insertion. What would update instructions have to do with seamless insertion? Why the Examiner believes that instructions that are used for seamless insertion somehow can be called update instructions in a claim that calls for instructions and update instructions is never explained.

Also cited is column 14, lines 52-67. This material includes a discussion of a selected insertion's decompression and warping to the appropriate pose by a video warping unit 160. The warping is apparently to make the insert meld with what is already there. There is no explanation why warping would constitute update instructions. Nor is there any effort to show what an update for an advertisement is or how an advertisement that was going to be used is automatically replaced with the update, as claimed. The assertion that warping reads on updating instruction is strained, contrived, and evidently without basis.

The next asserted update instruction is the instructions provided that allegedly change one advertisement to another advertisement, such as the enabling key, usage profile keys, and program category code. None of these change from one advertisement to another and none of these could even remotely be asserted to be updates. The material at column 7, lines 1-12 is totally non-informing. It talks about a user enabling key, usage profile keys, and a program category code, none of which are explained and none of which have any reasonable relationship to updates for advertisements. Nothing suggests any ability to replace advertisements with updates that are more timely. The material the Examiner cites suggests that after having received these items, the central studio site would be responsible for supplying "conventional video advertising" which also may be targeted using anonymous profile targeting methodology. Again, there is no reasonable basis for asserting these are updates.

Also cited are lines 50-53 of column 7, again, detailing keys and profiles and different assertions that may be permanently stored locally or downloaded. Again, nothing suggests any kind of ability to update or replace existing advertisements. Again, no effort is made to point out why these items might be update instructions.

Also cited is column 13, lines 25-48. But all this material talks about is, at the time for advertising insertion, the central controller places the appropriate advertisement on the end user's viewing device. Again, why is this an update? Plainly, it is simply the advertisement insertion. Again, there is no reason to believe any of these things are updates and anything other than the insertion of the regular advertisement. The Examiner then makes the totally unsupported claim

that “these update instructions in Rosser, replace the default advertisement with an advertisement appropriate for the subscriber’s set top box 44.” The problem is there is no default advertisement, the Examiner never points one out, and never shows any language where anything is replaced with anything else. The rejection is a fabrication of the Examiner’s imagination without any support within the reference.

Therefore, reversal of the rejection on this ground is respectfully requested.

**2. Does Rosser Teach Storing Content
as Opposed to Storing Advertisements?**

Now in the Answer, the Examiner attempts to read something into the word “typically” in the cited reference. See Rosser at column 13, line 20. He suggests that the cited reference is teaching that typically only advertisements are stored suggests, therefore, that “atypically” something else is stored and for some reason, the Examiner concludes that this something else is content. We do not know what is done atypically because the reference does not say. There is no reason to conclude that it would be content simply because now the present application claims content. There is no reason to know what is done “atypically” because the reference does not say anything about such a hypothetical atypical operation. The unsupported conclusion with the benefit of hindsight that “atypically,” both content and advertisements are stored is, again, nothing but an attempt to read into the reference that which is never taught by it.

There is no relevancy to the conclusion in the sentence bridging pages 8 and 9 of the Answer that the claims do not define the nature of the content. It is clearly something other than an advertisement.

Now, for the first time on appeal, the Examiner claims that the limitation, a cache ... to store ..., is a functional limitation or intended use. The Examiner has read this limitation consistently through prosecution to be a structural limitation. See Final Rejection at page 3, first indented paragraph. A limitation of of an element “adapted to” or simply “to” to do something is a structural limitation. See *Pac-Tec v. Amerace*, 14 U.S.P.Q.2d 1871, 1876 (Fed. Cir. 1990); *In re Venezia*, 189 U.S.P.Q. 149 (CCPA 1976) (“For example, paragraph two of claim 31 calls for “a pair of sleeves ... each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables.” Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve.”)

For the first time on appeal, the Examiner argues that because a RAM could store both contents and advertisements this teaches the claimed limitation. But this is based on an improper belief that the language of the claim is functional as opposed to structural. It is structural as the Examiner has consistently viewed it during the entire prosecution in this case and as required by Federal Circuit and CCPA case law. Given that case law and that prior reading, the Examiner's attempt to argue what the RAM could do when the reference does not store content and advertisements is inappropriate.

The problem is that not only does the reference not teach what is claimed, it cannot do what is claimed because it has no way to get the content into the RAM, because all that connect to the RAM in Rosser include advertisements, not content. The Examiner would need to re-engineer the reference to make it able to do what he says it is able to do.

While the RAM could store anything, all it does store is advertisements, as the reference clearly explains at column 13, lines 19-21. The assertion that because Rosser teaches a VCR he could store anything, ignores the fact that the connections and arrangements of the RAM must be such to store content and advertisements. This Rosser never thought of. Plainly, there is no storage of both advertisements and content. That is part of what is wrong with Rosser from a technical standpoint. He simply does not store the content and thinks he can proceed without doing so.

On page 9 on the last paragraph, the Examiner now reads "cached content" to be broad enough to read on any temporary buffering or caching of video. Even if this is so, "cached content" clearly distinguishes content from advertisements. This is the way the Examiner has read the claim from the beginning, this is what the words in the claim mean -- the fact that the applicant has appealed does not change what the claim means.

Most surprising is the citation to the MPEG II standard. The Examiner now contends, for the first time on appeal, that because some reference mentions MPEG that it can use the MPEG standard itself. The Examiner then tries to incorporate every example in the MPEG standard (which is hundreds of pages long) into his rejection. This is, again, an apparent effort to try to find something to bolster what was and still is a completely baseless rejection.

Without providing the appellant or the Board with the entire document, the Examiner attempts to crop quotes from the document to suggest that what is shown there is somehow required by the MPEG II standard. This is clearly not apparent from what the Examiner

provides. Moreover, to suggest that the MPEG standard requires storing both content and advertisements is, of course, ridiculous.

Rosser at column 10, lines 5-12 talks about MPEG II decompression. This certainly does not justify putting in specific embodiments from the MPEG II standard, nor does it suggest anything about caching both content and advertisements.

Finally, grasping at more straws, the Examiner attempts to rely on a delay line 86 shown in Figure 2. How the delay line 86 helps the Examiner's cause is never really explained. The delay line itself is virtually unexplained, as is the basis of the reliance on it for the first time in the appeal. In short, the reference has nothing to do with updates, nothing to do with replacing advertisements with updates, and nothing to do with caching both advertisements and content. Instead, the reference believes that he does not need to cache content because he can somehow just inject the advertisements into the streaming content. This is somehow achieved by the video insertion 90.

As best as can be determined, the combination of content and advertisements is done in the MUX 102. See Rosser at column 10, lines 36-44. A MUX is not a storage device. There is no storage of the content but, instead, somehow the reference expects that the advertisement be inserted into the streaming content. This is directly teaching away from the claimed invention which suggests caching the content and inserting the advertisement in the cached content. This is nowhere suggested in the cited reference.

3. Dependent Claims

Claim 48 calls for a receiver to receive an update, the receiver to use the pointer to update at a location. As described above, nothing even contemplated updating in the cited reference. The Examiner claims that he took official notice at the time the invention was made of certain things. The applicant never traversed that official notice. Now, apparently desperate to try to bolster an improper rejection, the Examiner improperly cites a reference in support of the official notice that was never traversed. But since the applicant never traversed the finding of well known art, the citation of a reference in support and an obvious attempt to find something that shows more than what official notice was taken of is plainly improper. This is yet another example of the efforts, on appeal, to not only morph the reference, but also to modify the original rejection. These attempts to morph the reference and change the rejection are still insufficient to

make out a proper rejection. The late identified reference does not teach anything relevant here and is not of record anyway.

Moreover, the effort to show a rationale to combine in what was originally the rejection under Section 102 is also improper.

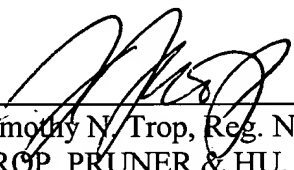
Payton has nothing to do with storing content and advertisements, nothing to do with updating advertisements, and nothing whatsoever to do with the claim. Even if user profiles are stored at the set top box, their pertinency to update instructions or pointers for update instructions is missing. There is no pointer and there is no rationale to modify either reference to bring up the pointer to find an update. The rejection is improper, woefully inadequate, and untimely.

No rebuttal of the comments made in the Appeal Brief with respect to claims 49 and 50 is provided by the Answer.

For all these reasons, the rejection should be reversed.

Respectfully submitted,

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